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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Stolt-51

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39703

7590

04/01/2009

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EXAMINER

OMGBA, ESSAMA

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,747	Applicant(s) ALLIOT ET AL.	
	Examiner Essama Omgba	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 9-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/5/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species A: A method of joining plastic-lined conduits

Species B: A method of offshore pipeline fabrication and laying

Species C: A tubular bridging member

Species D: An expansion tool

Species E: A pipe laying apparatus

Species F: A plurality of lined metal pipe sections

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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2. The claims are deemed to correspond to the species listed above in the following manner:

Species A: claims 1-8

Species B: claims 9-16

Species C: claims 17-21

Species D: claims 22-30

Species E: claims 32 and 33

Species F: claim 34

The following claim(s) are generic: claim 1.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: in accordance with the guidance set forth in MPEP §1850, it has been determined a posteriori, i.e. after taking the prior art into consideration, that the features of independent generic claim 1, do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of US Patents 6,226,855 to Maine and 7,431,341 to McIntyre> specifically note that Maine teaches all the claimed method steps as disclosed in columns 2 and 3, except for the specific bridging member that is taught by McIntyre as shown in figure 1.

4. During a telephone conversation with Mr. James Bushman on March 13, 2009, a provisional election was made with traverse to prosecute the invention of Species A, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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6. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maine (US Patent 6,226,855) in view of McIntyre (US Patent 7,431,341).

With regards to claim 1, Maine discloses a method of joining plastic-lined conduits comprising the steps of providing first and second conduits (16, 16A), each conduit comprising a wall of metal defining a bore having an open end for connection and being substantially lined by a plastic liner 18, 18A (col. 1, lines 55-59), the liner ending within the bore to leave a short unlined section at the open end of the conduit (fig. 2), arranging the first and second conduits with their ends abutting and welding the ends together to form a longer conduit (col. 3, lines 9-10), providing a tubular bridging member 2 of corrosion resistant member dimensioned to fit inside the conduits (col. 2, lines 16-20), the bridging member having first and second sealing portions (4, 6) towards ends thereof, the sealing portions being interconnected by an intermediate portion 8, the length of the intermediate portion being sufficient to bridge the unlined portions of the abutting first and second conduits while the first and second sealing portions overlap the liners within the first and second conduits respectively (fig. 2), with the first sealing portion of the bridging member located within the first conduit and overlapping the liner, expanding the first sealing portion radially so as to press the first sealing portion against

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the liner to form a first seal between the liner and the bridging member (col. 2, lines 53-66), and with the second sealing portion of the bridging member located within the second conduit and overlapping the liner of the second conduit, expanding the second sealing portion radially so as to press the second sealing portion against the liner to form a second seal between the liner and the bridging member (col. 3, lines 3-8), whereby the liners, the first and second sealing portions and the bridging members form a continuous barrier between the interior bore of the lined conduits and the metal of the conduit walls (col. 3, lines 24-28). Maine does not disclose the dimensions of the bridging member and the sequence of the method steps to be such as to insure that there is a space between the material of the bridging member and the inside of the abutting ends of the conduits during at least an initial pass of the welding step. However McIntyre teaches a bridging member 1 interconnecting two lined pipes 2 wherein the dimensions of the bridging member and the sequence of the method steps are such as to insure that there is a space between the material of the bridging member and the inside of the abutting ends of the conduits during at least an initial pass of the welding step, see column 4, lines 30-38 and figure 1. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the intermediate portion the bridging member of Maine with the intermediate portion taught by McIntyre, in order to avoid the bridging member or the liners being damaged by heat generated during the welding process.

Regarding claims 2, 3, 5, 6 and 8, Applicant should note that the sequence of the steps is an obvious matter of design choice.

Regarding claim 4, see figure 2 of Maine.

Allowable Subject Matter

9. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Essama Omgba/
Primary Examiner, Art Unit 3726

eo
March 30, 2009